

## REMARKS

Applicant respectfully requests consideration of the subject application. This Response is submitted in response to the Office Action mailed January 7, 2009. Claims 1-63 are pending. Claims 1-21 are withdrawn from consideration. Claims 22-63 are rejected. In this Amendment, claims 22, 30-32, 34, 42, 46, 49, 57 and 61 have been amended. Claims 63-65 are new. No new matter has been added.

### 35 U.S.C. § 112 Rejections

The Examiner has rejected claims 22, 46 and 61 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner states as follows:

*"The claims recite modules. Claim 22 narrowly defines the modules as a set of data, however neither the original claims nor the specification disclose modules. This limitation therefore constitutes impermissible new matter. Examiner further notes that the limitation module is broad and may be reasonably interpreted to constitute more than a set of data in the context of claims 46 and 61 because claims 46 and 61 do not depend from claim 22. Because the original disclosure offers no guidance for the interpretation of module in the claims, the limitation is construed as broadly and constitutes impermissible new matter."*

There are numerous references in the description relating to a "function" or a "procedure." For example, paragraph [0032] states as follows:

*"FIG. 2 is a printout of a search provider's web page 24 according to the present invention that is displayed on a user computer's monitor (not shown) as a function of a program stored in a memory ..."*

Referring to page 22, there are shown functions or procedures for determining a pacing factor to cap out the account in X days; determining the number of stats days

remaining; calculating the pacing factor based on the cap remaining, etc. Larger, more encompassing functions or procedures may for example be a search engine such as described on page 24 or a featured ad such as described on page 29.

Applicant therefore submits that there are ample references to "function" or "procedure" in the description. Applicant has, accordingly, amended claims 22, 46 and 61 so that they refer to "function" instead of "module."

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 22, 46 and 61 under 35 U.S.C. § 112, first paragraph due to their reference to "modules."

The Examiner has rejected claims 30, 42 and 57 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner states as follows:

*"The claims recite the advertiser data determines which search results are extracted by the search engine. Neither the original claims nor the specification disclose this feature. This limitation constitutes impermissible new matter."*

Applicant submits that this feature is described in the description. For example, paragraph [0049] states as follows:

*"In the tenth step 158 of the optimization process, if the random number is greater than the pacing factor, that sponsor's ad is not considered for display in the search provider's web page 24. Thus, the pacing factor, in combination with the MPF value described above, is utilized by the search engine server to reduce the likelihood of a user viewing a sponsor's ad on the search provider's web page and subsequently clicking on links 52 and 78 included in the sponsor's ad when the ad has already met its cap amount."*

This paragraph thus clearly states that some advertisers' ads will be included and some will not be based on the pacing factor. The pacing factor, which is based on the advertiser data, determines which advertisements are included. Search engine extraction is also described in the code starting on page 24.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 30, 42 and 57 under 35 U.S.C. § 112, first paragraph because these claims fail to comply with the written description requirement because the claims recite the advertiser data determines which search results are extracted by the search engine.

The Examiner has rejected claims 34 and 49 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner states as follows:

*"The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The claims recite operating a search engine to extract a plurality of search result from the advertiser entries based on the sales category and the geographic location data. Neither the original claims nor the specification disclose the limitations sales category and geographic location data. Further the original disclosure does not contemplate extracting data based on the above limitations. Claims 34 and 39 also recite mapping the query to at least one sales category among a plurality of sales categories. Neither the original claims nor the specification disclose the limitations sales category and geographic location data and further the original disclosure does not contemplate mapping search queries; the only "mapping" feature in the original disclosure is concerned with identifying business locations on a geographical map. Mapping search queries is a much broader concept. Therefore, these limitations constitute impermissible new matter."*

Applicant submits that these concepts are clearly described in the description.

Paragraphs [033], [034], [038], [041], [042], [043] and [045], for example, all describe searching based on geographic region and search category. Details of such searching are described in Appendix A of the specification, and in particular on pages 25 and 26.

Mapping of queries to sales categories is described on page 25, lines 5-13, which state as follows:

```
"my $rkw = {}; # Restrictive Keywords
## let's go get some data about what I'm looking at
## Site target ids
my $page_type_id = &Guide::Model::PageTypes::name_to_id($params->{page_type}); my ($site_target_id, $min_dist, $max_dist, $sales_cats) = &Guide::Model::SiteTargets::name_to_id({
page_type_id => $page_type_id,
page_type_data => $params->{page_type_data},..."
```

The sales categories (*\$sales\_cats*) are thus determined by mapping queries (*page\_type\_data*; *Restrictive Keywords*) to at least one sales category.

Geographic location data is described on page 25, lines 23-28, which states as follows:

```
"## Market / Point radius searching
if ($params->{lat} and $params->{long}) {
  $search_params->{lat} = $params->{lat};
  $search_params->{long} = $params->{long};
  $search_params->{miles} = ($max_dist * $multiplier);
  $ad_data->{metro_mode} = 0;"
```

By way of example, geographic data is described in terms of latitude (*lat*), longitude (*long*) and area (*Point radius searching*; *miles*).

Extraction of data based on sales category and geographic location data is described on page 26, lines 8 to 12, which states as follows:

```
"# Let's get to rock'n -- Set up new searcher
my $search = new Search::Model::Query();
my $total_ads;
foreach my $ad_type_id (keys %{$ad_data->{limits}}) {
    $total_ads += $ad_data->{limits} -> {$adtype_id} ;"
```

In this section, search results (*my \$search*) are extracted based on ad data (*\$ad\_data*) and page 25 defines ad data both in term of sales categories and geographic location data.

Applicant therefore respectfully submits that the description sufficiently describes limitations for sales category; geographic location data; extracting data based on these limitations; and mapping a query to at least one sales category among a plurality of sales categories.

The Examiner then continues in the same paragraph to state as follows:

***"Examiner's note: With regard to that above new matter rejection of the geographic location data limitation, Examiner recognizes that the specification discloses and defines coverage area, geographic region of consideration and single-location/multiple-location sponsor. Further examiner understands that geographic location data may be understood to be synonymous or descriptive of the above terms. However, under MPEP § 2111 Examiner must interpret geographic location data broadly, and this limitation when interpreted reasonably broad constitutes additional information/concepts that are not disclosed in the specification. Because this new limitation is not narrowly defined in the specification, Examiner must interpret this new limitation as impermissibly broader than the original disclosure."***

Applicant appreciates that the term "geographic location data" can have a multitude of technical and virtual meanings. However, when doing local searching, you are looking for businesses or services in your geographic area. Even upon a cursory

review of the specification, it should be clear that it is this type of geographic locally searching that is contemplated by this invention. Geographic location data cannot be interpreted in a vacuum and without consideration of the specification. Geographic location data, within the context of the present patent application, may for example include latitude, longitude, zip code, state, city, etc. Of course, the claims are not limited to any particular one of these examples or even to determining location directly, within the understanding of patent law in general.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 34 and 49 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written requirement.

The Examiner has rejected claims 30, 42 and 57 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner states as follows:

*"The claim recites the advertiser data determines which search results are extracted by the search engine. It is neither disclosed in the specification, nor understood in the art, how data can make determinations. Usually only human operators or computer processors can make determinations."*

Applicant has amended these claims to recite that the advertiser data forms a basis for which search results are extracted by the search engine. Applicant submits that the amendment overcomes the Examiner's rejection. Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 30, 42 and 57 under U.S.C. § 112, second paragraph.

The Examiner has rejected claims 31, 46 and 61 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner states as follows:

*"Claims 31, 46 and 61 are specifically directed to a geo-location module. Claim 22 broadly discloses a plurality of modules and defines these modules as data, it recites a set of data... the set of data including then lists the modules among other elements data. This is the only definition of module in the entire disclosure and the term module was not part of the original disclosure, so Examiner relies on this definition when interpreting the subsequent claims even though claims 46 and 61 do not depend from claim 22. In Claims 31, 46, and 61, however, Applicant claims the geo-location module as a component of the system, method or computer-readable medium with the language the system/method/computer readable medium... further comprising: a geo-location module. It is not known in the art how a set of data may comprise a structural component (as in claim 31), a step of a method (as in claim 46), or a feature/component of a computer-readable medium (as in claim 61). Because the disclosure does not clarify for one having ordinary skill in the art how data may on its own have structural integrity, comprise an active step in a method or comprise a feature (structural or functional) of a computer-readable medium, the claims are indefinite. For the purposes of this examination, module is interpreted to mean data as defined in Claim 22."*

Applicant has amended claim 31 to state that it is the set of data of the computer system that further comprises the geo-location function. The term "module" has also been replaced with "function," consistent with claim 22. Claim 32 has been amended in a similar manner. Claim 46 has been amended to remove the structural limitation of a geo-location module and, instead, reciting a step of determining a location of a user computer system utilizing a geo-location function. Claim 61 has been amended to state

that it is the data on the computer readable medium that further comprises the geo-location function.

Applicant submits that the amendments to claims 31, 46 and 61 overcome the Examiner's rejections, and accordingly, respectfully requests withdrawal of the rejections of claims 31, 46 and 61 under U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

#### U.S.C. § 101 Rejections

The Examiner has rejected claim 34 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

The Examiner states as follows:

*"Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claim 34 fails to meet the above requirements because it is neither transforms underlying subject matter nor is it tied to a second statutory class of invention. The steps of receiving and transmitting are considered insignificant extra-solution activity, so whether or not the network constitutes a second statutory class of invention is moot."*

Applicant submits with respect that there is no support in *Diamond v. Diehr* for the Examiner's assertion that a network cannot constitute a second statutory class. Furthermore, the step of "receiving" is tied to a network, a user computer system and a server computer system. Applicant also points out that the steps of "receiving" and



“transmitting” are important for the functioning of the present invention and are not to be considered insignificant extra solution activity. In fact, the invention as claimed cannot function without these essential steps.

The Examiner then proceeds to state as follows:

*“The preamble recitation a computer-based method does not satisfy the requirement because the preamble lends no patentable weight to the claim.*

In *In re Paulson*, 30 F.3d 1475 it was held that terms appearing in a preamble may be deemed limitations of a claim if they “give meaning to the claim and properly define the invention.” Applicant submits that “computer-based method” does provide interpretation to the claim, especially since computers fall in a specific statutory class of machines. The Examiner then proceeds as follows:

*“The limitation operating a search engine does not satisfy the requirement because a human operator may complete this step and satisfy the claim and human operators are not statutory classes of invention. Examiner notes that the search engine here completes the “extraction of results” but this step is not positively recited in the claim, only the step of operating is positively recited.”*

Applicant submits with respect that the Examiner is reaching beyond the scope of normal interpretation of one of ordinary skill in the art of the present patent application when asserting that a search engine can be a human being. Furthermore, the step that the Examiner is referring to and numerous other steps have been amended to state that at least one processor of a server computer system carries out these steps. Certainly the brain of a human being cannot be considered a processor of a server computer system!

Applicant, accordingly, respectfully requests withdrawal of the rejection of claim 34 under 35 U.S.C. § 101 as being directed to non-statutory subject matter .

The Examiner also rejected claim 49 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The Examiner states as follows:

*"The computer-readable medium having stored thereon a set of data that is at least readable by a processor of a computer to execute a method of Claim 49 is not a process, machine, manufacture, or composition of matter, or any improvement thereof. Here the "data" has no functionality because it is only "readable" by a computer. The data may be able to execute a method (such as a list of instructions or printed computer code), but in this claim the data is merely stored on the medium such that it is readable and not executable. To be statutory the data must be executable. Examiner recommends the following: "a computer-executable program product tangibly embodied on a computer readable medium." For the purposes of this examination, this claim and its dependents are interpreted as method claims because the bodies of the claims reflect the format of method claims."*

Applicant has opted to replace "at least readable" with "executable." According to the Examiner's suggestion that the claim is rejected because the data is only "readable" by the computer, it appears that the claim would be acceptable by the Examiner by making the said amendment. Applicant, accordingly, respectfully requests withdrawal of the rejection of claim 49 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

#### 35 U.S.C. §103 Rejections

The Examiner has rejected claims 22-63 under 35 U.S.C. § 103(a) as being unpatentable over Cheung, et al., (U.S Patent Publication No.: 2003/0028529, hereinafter "Cheung") in view of Leishman, et al., (U.S Patent Publication No.:

2004/0073538, hereinafter "Leishman"). Applicant submits that these claims are patentable over the cited references.

With respect to claim 22, the Examiner states as follows:

*"Examiner's Note: Applicant properly claims a system in the claim below, however the system of this claim is extremely broad as it is only limited to a processor and a medium containing data that the processor is at least capable of reading. This system can for example describe a scanner (processor) with a piece of paper containing data (the medium) on the scanning portion of the scanner (readable). There is no functional relationship between the data in this claim and the processor or the medium. In this situation patentable weight is not given to the data elements in the claim because the data is not functional but merely descriptive."*

Not all the data elements in Claim 22 are executable by a processor, since some of them are data that would be only readable by the processor. Those elements that are functions that are executable have been amended to recite that the functions are executable by the processor. The latter elements have thus been tied to the processor and there is thus a functional relationship between elements the data in this claim and the processor. Applicant believes that the amendment overcomes the Examiner's rejection and this regard.

The Examiner then proceeds to state that the Examiner nevertheless believes that:

- (i) Cheung discloses all the limitations of claim 22 except for geographic data of a location;
- (ii) Leishman discloses geographic data of a location; and
- (iii) *"It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the additional data of the Leishman invention with the Cheung invention since the claimed invention is merely a combination of old elements,*

*and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.”*

With respect to the Examiner’s assertion under (iii) that one of ordinary skill in the art would be motivated to combine Cheung and Leishman, Applicant submits herewith an affidavit by an inventor of the present patent application, Russell Alan Foltz-Smith. The Examiner will note from the Affidavit that Mr. Foltz-Smith is one of extraordinary skill in the art of the present invention. The Examiner will also note that Mr. Foltz-Smith believes that the invention would not be obvious over the combination of Cheung and Leishman at the time that it was made.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 22-63 under 35 U.S.C. § 103103(a) as being unpatentable over Cheung in view of Leishman.

#### New Claims

New claims 64-66 have been added that relate to the pacing function that is described in paragraphs [046] to [051] of the specification. This pacing factor is not described in the references, alone or in combination. In addition, the attached Affidavit by Russell Alan Foltz-Smith states that such pacing would not be obvious within the context of the present invention.

Applicants respectfully submit that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Stephen M. De Klerk at (650) 798-0342.

Please charge any shortages and credit any overages to Deposit Account No. 19-3140. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 19-3140.

Respectfully submitted,  
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